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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,712	06/23/2003	Michael Francis Dube	14150-00601	5751
25243	7590	05/09/2006	EXAMINER.	
KELLEY DRYE & WARREN LLP 3050 K STREET, NW SUITE 400 WASHINGTON, DC 20007			MAYES, DIONNE WALLS	
			ART UNIT	PAPER NUMBER
			1731	

DATE MAILED: 05/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/600,712

Applicant(s)

DUBE ET AL.

Examiner

Dionne Walls Mayes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-10,13,15-18,21-30,33,35-37,40,41,44,45 and 47-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 33 is/are allowed.
- 6) ☒ Claim(s) 1,3-10,15-18,21-30,35-37,40,41,44,45 and 47-60 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Withdrawal of Previously Indicated Allowable Subject Matter

1. The indicated allowability of several claims are withdrawn in view of the newly discovered reference to Leake et al, and in view of the reconsideration of the Berger '646 reference. Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. The terms "*generally* circular", "*generally* spherical", "*generally* cross-shaped form", and "*generally* conically shaped" in the claims are relative phrases which render the claims indefinite. These phrases are not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1,3,5,8,9-10,16,18,21,23-26,29-30,36,41,44-45, 51-54 are rejected under 35 U.S.C. 102(b) as being anticipated by Leake et al (US. Pat. No. 3,428,049).

Leake discloses all that is recited in the claims (See Fig. 1, and cols. 2-3) since Leake discloses a tobacco smoke filter element, attached to a tobacco rod, having a

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cylindrical sleeve of compressed absorbent material ("inner filter material"), defining a cavity, contained within uncompressed filter material ("outer filter material"), said sleeve containing a frangible capsule containing a tobacco smoke-treating liquid medium ("breakable capsule"). An additional filter is provided on the side of the filter element farthest from the tobacco rod.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 3-10, 15-16, 18, 21-30, 35-36, 41, 44-45, 47-55, 57-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berger et al (US. Pat. No. 3,599,646) in view of Dock (US. Pat. No. 3,625,228).

Berger et al discloses nearly all that is recited in the claims, since it teaches a tobacco rod 22, and a filter element 20 connected to said rod. The filter element 20 has an inner member 36 (corresponding to the claimed "inner element of filter material"), comprised of a filter material which may be cellulose acetate, which has a cavity 48 which can be configured such that it faces/is exposed to the tobacco rod 22. Filter element 20 also has an outer member 34 (corresponding to the claimed "outer element of filter material" since, due to its paper construction, obviously renders it a material capable of filtering some amount of matter from cigarette smoke). The filter element 20 has all of the structural elements recited in the claims, either as explicitly stated,

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represented by the figures or inherently. While Berger may not specifically state that at least one breakable capsule is disposed in the cavity, it does state that materials for flavoring smoke may be provided in the cavity (see col. 1, lines 54-58). Further, Dock discloses heat-activated capsules, appearing to be the claimed sizes, that rupture upon exposure to heat and are designed to be disposed within cigarette filters to deliver flavorants to the user during the smoking of the cigarette (see cols. 1 and 2, and Fig. 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to have incorporated one or more of these capsules into the cavity of the filter of the combined Berger references in order to receive the benefit of heat-activated capsules for imparting much-desired flavor, i.e. menthol, to cigarette smoke. Also, the filter of Berger modified by Dock would contain regions in said cavity for receipt of capsule contents following rupture of said capsule(s).

Lastly, since the filter segment of Berger modified by Dock is the same, structurally, as that of the instant invention, it follows that it would also be capable of exhibiting the same characteristic of decompressing/attaining a functional shape after compressing.

8. Claims 15,17,35,37,40,55-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leake et al (US. Pat..No. 3,428,049).

While Leake et al may not specifically state that either the inner or outer filter elements are made of the materials claimed, it follows that one having ordinary skill in the art would have fabricated either of the filter materials of fibrous materials such as cellulose acetate since such is conventional material of fabrication for cigarette filters.

Allowable Subject Matter

9. Claim 33 is allowed.
10. Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion


11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- WO 03/009711

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne Walls Mayes whose telephone number is (571) 272-1195. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dionne Walls Mayes
Primary Examiner
Art Unit 1731

May 5, 2006